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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,091	05/08/2001	Etsuko Matsunaga	206445US0CONT	1424

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EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT PAPER NUMBER

1638

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/850,091

Applicant(s)

MATSUNAGA ET AL.

Examiner

Medina A Ibrahim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 4-5, 9-10 and 25-26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's response filed 10/02/03 in reply to the Office action mailed 06/02/03 has been entered.

Claims 1-26 are pending and are under examination.

All previous rejections and objections not stated below have been withdrawn.

Claim Rejections - 35 USC § 112

Claims 1-3, 6-8 and 11-24 remain rejected under 35 U.S.C. 112, first paragraph, because the specification is enabling only for claims limited to a method of introducing a gene into a plant comprising introducing into a plant a vector comprising the cytokinin-related gene of CKI1 as a selectable marker gene under the control of a light inducible promoter and the vector. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. This rejection is repeated for the reasons of record as set forth in the last Office action mailed 06/02/2003.

The claims are broadly drawn to a method for introducing a desired gene into a plant, comprising introducing a vector comprising any cytokinin-related gene as a selectable marker gene under the control of a light inducible promoter, or further comprising a removable DNA and a method for producing a transgenic plant free from the influence of a selectable marker comprising transforming said plant with said vector, wherein the selectable marker gene, and not the desired gene, is positioned such that it behaves integrally with the removable DNA, and transgenic plant and plant cells produced by said method. The claims also encompass the cytokinin-related gene of CKI1 as a selectable marker and specific removable DNA element and a method for

improving redifferentiation efficiency of a transgenic tissue with said vector. In contrast, the enabled disclosure is limited to a method that employs ipt or CK11 as a selectable marker.

The specification does not provide sufficient guidance for how to identify which of the numerous different cytokinin- related genes are suitable for the claimed methods. Walden et al (Eur. J. Biochem, vol 192, pp. 563-576, 1990), disclosed in the last Office action, teach that not all selectable markers function uniformly in all plant species, and that markers required for dominant selection may differ between not only different plant species but also different cell types within an individual. One skilled in the art, who is willing to practice the claimed invention, would have to identify and test all genes that are directly and/or indirectly related to cytokinin, and determine which of these genes can be used as selectable markers as set forth in the claimed methods. These tests are considered excessive and undue. Applicant has provided no scientific evidence to support the conclusion that any cytokinin-related gene can be used to improve plant genetic transformation efficiency, and with any removable DNA for the production of transgenic plants free from the influence of selectable markers.

In Genentech Inc v. Novo Nordisk A/S (42 USPQ2d 1001 at p. 1005). The CAFC stated, "(P)atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable....While every aspect of generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention...". . See also *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970)

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where it states " the scope of enablement must only bear a "reasonable correlation" to the scope of the claims.

For the reasons discussed above and in the last Office actions, the claimed invention is not enabled throughout the broad scope. Therefore, the rejection is maintained.

Remarks

Claims 4-5, 9-10 and 25-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Information


Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM .

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804.

1/9/04

Mai


ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1800